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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/535,002	05/12/2005	Mary Margaret Mader	X16114	9111
25885	7590	07/14/2006	EXAMINER	
ELI LILLY & COMPANY PATENT DIVISION P.O. BOX 6288 INDIANAPOLIS, IN 46206-6288			YOUNG, SHAWQUIA	
			ART UNIT	PAPER NUMBER
			1626	

DATE MAILED: 07/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/535,002	MADER ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Shawquia Young	1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) 4 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☒ Claim(s) 1-3 and 5 (in-part) is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>5/12/05</u> . | 6) <input type="checkbox"/> Other: ____.  |

## **DETAILED ACTION**

Claims 1-5 are currently pending in the instant application.

### **I. *Priority***

The instant application is a 371 of PCT/US03/35041, filed on November 13, 2003, which claims benefit of the Provisional application 60/428,891, filed on November 22, 2002.

### **II. *Information Disclosure Statement***

The information disclosure statement (IDS) submitted on May 15, 2005 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement has been considered by the examiner.

### **III. *Restriction/Election***

#### **A. *Election: Applicant's Response***

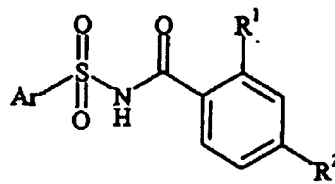
Applicants' election with traverse of Group III in the reply filed on June 16, 2006 is acknowledged. The traversal is on the ground(s) that the claimed invention involves the same "special technical feature" which defines a contribution over the art and thus unity of invention does exist.

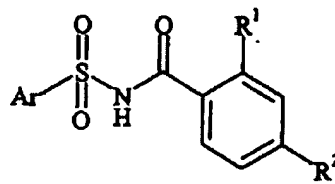
All of the Applicants' arguments have been considered but have not been found persuasive. It is pointed out that the restriction requirement is made under 35 U.S.C. 121 and 372. 35 U.S.C. 121 gives the Commissioner (Director) the authority to restrict applications to several claimed inventions when those inventions are found to be independent and distinct. The Examiner has indicated that more than one independent

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and distinct invention is claimed in this application and has restricted the claimed subject matter accordingly.

Applicants argue that according to the unity of invention standard set forth in PCT Rule 13.2, unity of invention exists only when there is a technical relationship among the claimed inventions involving one or more of the same or corresponding "special technical features". However, the Examiner defines the special technical feature of the



compounds of the formula I as , wherein the benzoyl sulfonamide is attached to a fused polycyclic ring but does not include the variables R<sup>1</sup> and R<sup>2</sup>. The special technical feature was known in the prior art, wherein Ar is a naphthyl ring attached to the benzoyl sulfonamide moiety (See, Wilson, US 5/405,727 compound F). Therefore, the presence of the special technical feature in the prior art destroys the unity of the claimed invention which allows the claimed invention to be restricted under 35 U.S.C. 121 and 372. Since the applicants are claiming more than one invention, the Examiner restricted the different inventions according to classification.

Applicants argue that the alternatives of the Markush grouping can be differently classified, they are easily searchable. The Examiner points out that the Ar variable is defined in claim 1 as various heterocyclic groups, i.e. benzothien-2-yl, thieno[3,2-b]pyridin-2-yl, or 1-(C<sub>1</sub>-C<sub>6</sub> alkyl)indol-2-yl. The Ar variable controls the classification for the compounds which means that each heterocycle in the above example are in

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different classes. Therefore different search considerations are involved (i.e., class/subclass searches, databases searches, etc.) for each of the groups listed. The heterocycles listed in claim belong to the following classes: 514, 544, 548, and 549. However, each Class 514, 544, 548 and 549 encompasses numerous patents and published applications. For instance, Class 514 contained 165,171 patents and published applications. Therefore it would constitute a burden on the Examiner and the Patent Office's resources to examine the instant application in its entirety.

Applicant also argues that the method claim, claim 4, cannot be restricted from the compounds. However, as mentioned above, the unity of invention has been destroyed because the special technical feature does not define a contribution over the prior art. The Examiner has indicated that more than one independent and distinct invention is claimed in this application and has restricted the claimed subject matter accordingly.

Subject matter not encompassed by elected Group III are withdrawn from further consideration pursuant to 37 CFR 1.142 (b), as being drawn to nonelected inventions.

#### **IV. Objections**

##### **Claim Objection-Non Elected Subject Matter**

Claims 1-3 and 5 (in-part) are objected to as containing non-elected subject matter. To overcome this objection, Applicant should submit an amendment deleting the non-elected subject matter.

## **V. Allowable Subject Matter**

**Group III** claim(s) 1-3 and 5 (in-part) are drawn to compounds of formula (I) wherein: **Ar** is benzothien-2-yl, benzothien-5-yl, or benzothien-6-yl; **R<sup>1</sup>** and **R<sup>2</sup>** are either both halo or trifluoromethyl, or one is halo and the other is C<sub>1-6</sub> alkyl, is allowed. Claim 4 is drawn to nonelected subject matter and are not allowable at this time.

The closest prior art found is US 5405727.

## **V. Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shawquia Young whose telephone number is 571-272-9043. The examiner can normally be reached on 7:00 AM-3:30PM.

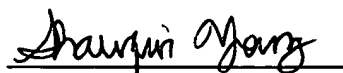
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph McKane can be reached on 571-272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Shawquia Young

Patent Examiner


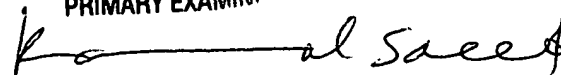
Art Unit 1626, Group 1620

Technology Center 1600

7/6/06

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